

UNITED STATES PATENT AND TRADEMARK OFFICE



BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WEN-SUNG TSAI

Application 09/683,729

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on August 22, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

An examination of the Image File Wrapper (IFW) reveals that an Order Returning Undocketed Appeal was mailed December 9, 2004 which requested clarification regarding the status of claim 13¹ and requested a

¹ The Final Rejection mailed April 11, 2003 indicated that claims 6, 7, 9, 10 and 12-14 were rejected, while the Appeal Brief filed December 10, 2003 stated that claims 6, 7, 9, 10, 12 and 14 were being appealed.

proper response to the Reply Brief filed April 23, 2004. A new Appeal Brief was filed on October 20, 2006 which stated that “[t]his amended appeal brief indicates that claim 13 has now been cancelled, and therefore the appeal of claim 13 is withdrawn” [page 2]. Section 1206 of the Manual of Patent Examining Procedure (MPEP) (Eighth Edition, Rev. 3, August 2005) states, in part:

A new amendment must be submitted in a separate paper.

Correction is required.

It should also be noted that the “Status of Claims” appearing on page 2 of the Appeal Brief appears to contain a typographical error in that claim 13 is listed as being cancelled and also rejected. Correction is required.

Lastly, on July 2, 2004, the examiner considered the Reply Brief filed April 23, 2004 but also appeared to include rebuttal. MPEP § 1208.03 (Eighth Edition, August 2001) states:

[A]ppellant may file a reply brief as a matter of right within 2 months from the mailing date of the examiner’s answer. . . . The primary examiner must then either:
(A) acknowledge receipt and entry of the reply brief by using form paragraph 12.47 on form PTOL-90; or
(B) reopen prosecution to respond to the reply brief.
See MPEP § 1208.02.

This discrepancy was previously noted in the Order Returning Undocketed Appeal mailed on December 9, 2004. Correction is required.

Accordingly, it is ORDERED that the application is returned to the Examiner to:

- 1) notify appellant to submit an amendment in a separate paper which cancels claim 13;
- 2) notify appellant to submit a new Appeal Brief which corrects the "Status of Claims" and "Status of Amendment" sections;
- 3) consider the new Appeal Brief;
- 4) properly respond to the Reply Brief filed April 23, 2004; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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PJN:psb

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